

PATENT
37945.00012.UTL.1**REMARKS/ARGUMENTS**

The following remarks address the rejections contained in the last Office Action prior to the filing of this RCE Application.

Drawings

Paragraph 1 of the Action noted that the Draftsperson has objected to the drawings. Applicant has submitted new drawings with this RCE Application that the Applicant believes address the Draftsperson's Objections.

Claim Objections

Paragraph 2 of the Action objects to claims 20, 21, 30, and 31 as a result of certain spelling errors contained in the claims. Applicant has cancelled claims 30 and 31 in the above amendments, thereby rendering this objection moot as to these claims. Applicant has amended claims 20 and 21 above to correct the misspellings. Accordingly, Applicant believes that the claim objections have been addressed.

Claim Rejections Under § 112

Paragraph 3 of the Action rejects claims 23 and 33 for lack of antecedent basis. Claim 33 has been cancelled by the above amendments thereby rendering this rejection moot as to this claim. Applicant further believes that the amendments to claims 22 and 23 made above, overcome the lack of antecedent basis. Accordingly, Applicant respectfully requests that the rejection be withdrawn as to claims 23 and 33.

PATENT
37945.00012.UTL.1**Claim Rejections Under § 102**

Paragraph 4 of the Action rejects claims 1, 3, 9, 11, and 40 under 35 U.S.C. 102(e), as being unpatentable in view of Garin (U.S. Patent 6,427,120). Claims 11 and 40 have been cancelled by the above amendments, thereby rendering the rejection moot as to these claims. Applicant, therefore respectfully request that the rejection be withdrawn as to claims 11 and 40. Applicant expressly reserves the right, however, to pursue any patentable subject matter contained in cancelled claims 11 and 40 at a later time.

With respect to claims 1 and 3, Applicant respectfully traverses the rejection because claims 1 and 3 have been amended to depend from newly added claim 41, which Applicant believes is allowable over the art of record for at least the reasons cited below. Applicant therefore respectfully requests that the rejection be withdrawn as to claims 1 and 3.

Paragraph 5 of the Action rejects claims 1, 3, 9, 11, and 40 under 35 U.S.C. 102(e), as being unpatentable in view of Tsujimoto (U.S. Patent 6,462,708). Claims 11 and 40 have been cancelled by the above amendments, thereby rendering the rejection moot as to these claims. Applicant, therefore respectfully request that the rejection be withdrawn as to claims 11 and 40. Applicant expressly reserves the right, however, to pursue any patentable subject matter contained in cancelled claims 11 and 40 at a later time.

With respect to claims 1 and 3, Applicant respectfully traverses the rejection because claims 1 and 3 have been amended to depend from newly added claim 41, which Applicant believes is allowable over the art of record for at least the reasons cited below. Applicant therefore respectfully requests that the rejection be withdrawn as to claims 1 and 3.

PATENT
37945.00012.UTL.1

Claim Rejections Under § 103

Paragraph 6 of the Action rejects claims 14-19 under 35 U.S.C. 103(a), as being unpatentable in view of Garin. Claims 14-16 have been cancelled by the above amendments thereby rendering the rejection moot as to these claims. Applicant, therefore respectfully request that the rejection be withdrawn as to claims 14-16. Applicant expressly reserves the right, however, to pursue any patentable subject matter contained in cancelled claims 11 and 40 at a later time.

With respect to claims 17-19, Applicant respectfully traverses the rejection for at least the reasons indicated below.

The Action states that Garin teaches each element of claim 17. Specifically, the Action states that Garin discloses a device configured to act as a standalone GPS receiver or to act as a network assisted GPS receiver when it is determined that network assistance is not available; however, in order for claim 17 to be render obvious by Garin, Garin must teach or suggest all the claim limitations of claim 17. Since as stated in the Action, Garin does not teach each and every element of claim 17, Garin must include some suggestion or motivation to modify the teaching of Garin. Garin must also include a reasonable expectation that any such modifications will be successful. The teaching or suggestion to make the modification to the teachings of Garin and the reasonable expectation of success must both be found in Garin and cannot based on applicant's disclosure. (see MPEP § 706.02(j)).

Claim 17 teaches a specific method for switching between operational modes in response to a received position request. Specifically, when the position request is received, the wireless communication device will first attempt to act in a network assisted mode by ascertaining the availability of network assist information. If no network assist information is available, then the

PATENT
37945.00012.UTL.1

wireless communication device will switch to GPS standalone mode. The switch to GPS standalone mode is specifically achieved by deactivating a wireless communication transceiver, activating a GPS receiver, and then receiving GPS signals via the GPS receiver.

Garin does indicate that device can take advantage of the multimode architecture taught therein by taking advantage of the network assist if it is available and can act independently if it is not (see col. 9, lines 4-9); however, Garin teaches several specific methods by which such a device can switch modes. First, Garin teaches that the device can switch from standalone mode to network assist mode "when a predetermined event occurs" (see col. 8, line 65). Such an event can be a lapse of a predetermined time in which no GPS signals are received (see col. 8, lines 66-67). Thus, the first method taught by Garin actually teaches the opposite of the method claimed in claim 17, i.e., where the device starts in a network assisted mode and then switches to a standalone mode if no network assist information is available.

The second method taught in Garin is the ability of a user to select standalone mode over network assisted modes (see col. 8, lines 27-49). This also is not the method taught by claim 17, i.e., the device starts in network assisted mode and looks for network assist information. Only if this information cannot be found, does the device then switch to standalone mode.

Finally, Garin teaches that a certain functions can call for certain reliability or timeliness of the positioning capability. Accordingly, a certain mode may be selected in order to supply the needed reliability (see col. 8, lines 49-51 and col. 9, lines 23-25). Again, this is not the method claimed in claim 17.

Because Garin teaches different methods for selecting between multiple operational modes than that taught by claim 17, Garin cannot render claim 17 obvious. Accordingly, Applicant respectfully requests withdrawal of the rejection as to claim 17. Further, because

PATENT
37945.00012.UTL.1

claims 18 and 19 depend from claim 17, which is allowable over the art of record, Applicant respectfully requests withdrawal of the rejection as to claims 18 and 19.

Paragraph 7 of the Action rejects claims 14-19 under 35 U.S.C. 103(a) as being unpatentable in view of Garin and in further view of Syrjarinne (U.S. Patent Pub. No. US2003/0107514). Claims 14-16 have been cancelled by the above amendments thereby rendering the rejection moot as to these claims. Applicant, therefore respectfully request that the rejection be withdrawn as to claims 14-16. Applicant expressly reserves the right, however, to pursue any patentable subject matter contained in cancelled claims 11 and 40 at a later time.

With respect to claims 17-19, claim 18 and 19 depend from independent claim 17. Garin is deficient with respect to claim 17 for at least the reasons stated above. Therefore, the Examiner must rely on Syrjarinne to compensate for the foregoing deficiencies.

Syrjarinne is drawn to a system for saving power in a GPS receiver. The Action states that Syrjarinne teaches turning off portions of a receiver when they are not being used. Syrjarinne fails, however, to teach the methods of multi-modal operation of the present application. Specifically, Syrjarinne fails to teach the method for switching from a network assisted mode to a standalone mode that is the subject of claim 17. Therefore, Applicant submits that claim 17 is patentable over the art of record. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection as to this claim. Further, because claims 18 and 19 depend from claim 17, which is allowable over the art of record, Applicant respectfully requests withdrawal of the rejection as to claims 18 and 19.

Paragraph 8 of the Action rejects claims 4-5, 12-13, 28, and 38 under 35 U.S.C. 103(a) as being unpatentable in view of Garin and in further view of Krasner '363. Claims 5, 12-13, and 38 have been cancelled by the above amendments thereby rendering the rejection moot as to these

PATENT
37945.00012.UTL.1

claims. Applicant, therefore respectfully request that the rejection be withdrawn as to claims 5, 12-13, and 38. Applicant expressly reserves the right, however, to pursue any patentable subject matter contained in cancelled claims 5, 12-13, and 38 at a later time.

With respect to claims 4 and 28, Applicant respectfully traverses the rejection because claims 4 and 28 have been amended to depend from newly added claim 41, which Applicant believes is allowable over the art of record for at least the reasons cited below. Applicant therefore respectfully requests that the rejection be withdrawn as to claims 4 and 28.

Paragraph 9 of the Action rejects claims 20-22, 24-27, 29, 30-32, 34-37, and 39 under 35 U.S.C. 103(a), as being unpatentable in view of Garin, in further view of Krasner '363, and in further view of Leisten (U.K. Patent Application GB 2347804). Claims 25, 30-32, 34-37, and 39 have been cancelled by the above amendments thereby rendering the rejection moot as to these claims. Applicant, therefore respectfully request that the rejection be withdrawn as to claims 25, 30-32, 34-37, and 39. Applicant expressly reserves the right, however, to pursue any patentable subject matter contained in cancelled claims 25, 30-32, 34-37, and 39 at a later time. Specifically, Applicant disagrees with the statement of obviousness related to claims 25 and 35 made in the Action.

With respect to claims 20-22, 24-27, and 29, Applicant respectfully traverses the rejection because claims 20-22, 24-27, and 29 have been amended to depend from newly added claim 41, which Applicant believes is allowable over the art of record for at least the reasons cited below. Applicant therefore respectfully requests that the rejection be withdrawn as to claims 20-22, 24-27, and 29.

Paragraph 10 of the Action rejects claims 20-21, 23, 30-31, and 33 under 35 U.S.C. 103(a) as being unpatentable in view of Garin, in further view of Krasner '363, and in further

PATENT
37945.00012.UTL.1

view of Standke (U.S. Patent Pub. No. US2003/0100333). Claims 30-31, and 33 have been cancelled by the above amendments thereby rendering the rejection moot as to these claims. Applicant, therefore respectfully request that the rejection be withdrawn as to claims 30-31, and 33. Applicant expressly reserves the right, however, to pursue any patentable subject matter contained in cancelled claims 30-31, and 33 at a later time.

With respect to claims 20-21 and 23, Applicant respectfully traverses the rejection because claims 20-21 and 23 have been amended to depend from newly added claim 41, which Applicant believes is allowable over the art of record for at least the reasons cited below. Applicant therefore respectfully requests that the rejection be withdrawn as to claims 20-21 and 23.

Miscellaneous Claim Amendments

Due to the claim amendments described above, several miscellaneous claim amendments were required to maintain consistency between the claims as well as between the claim language and terms. In making these miscellaneous claim amendments, Applicant believes that no new matter was added.

New Claims

Several new claims are added in the above amendments. Applicant believes that no new matter was added as a result of the new claims. Applicant also believes that these new claims are allowable over the art of record. Specifically, new independent claim 41 was added in the above amendments. Claim 41 is essentially the same as previous claim 5 written in independent form with the addition of the following element: "... a common IF block, interfaced with the common demodulation circuit, the common IF block configured to mix the demodulated signals down to

PATENT
37945.00012.UTL.1

baseband” Support for this element can be found in figure 4 (common IF block 422), and the accompanying description.

The Action rejected claim 5 over Garin in further view of Krasner ‘363 stating that Krasner ‘363 discloses the common demodulator taught in claim 5; however, Applicant believes that the combination of Garin and Krasner are deficient with respect to new claim 41 because each fails to show the common IF block taught in new claim 41.

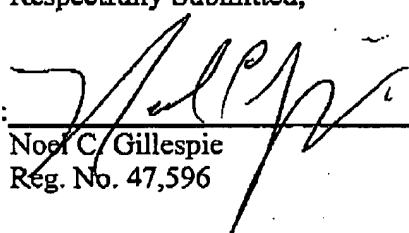
PATENT
37945.00012.UTL.1**CONCLUSION**

Upon entry of this amendment, claims 1, 3, 4, 17, 18, 19, 20 – 24, 26-29, and new claims 41-47 are pending. Claims 2, 5-16, 25, and 30-40 have been cancelled. Based on the above amendments and remarks, Applicants believe that the claims are in condition for allowance and such is respectfully requested. Applicants assert that no new matter has been introduced as a result of these amendments.

The Commissioner is hereby authorized to charge any fees required by this response to our Deposit Account No. 50-2613 (Order No. 37945.00012.UTL1).

Respectfully Submitted,

Dated: 14-Apr-04
PAUL, HASTINGS, JANOFISKY & WALKER
CUSTOMER NO. 36183
P.O. BOX 92191
SAN DIEGO, CA 92191-9092
PH: (858) 720-2500
FX: (858) 720-2555

By: 
Noel C. Gillespie
Reg. No. 47,596